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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/728,716

12/05/2003

Renato Colombo

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EXAMINER

LEE, CLOUD K

ART UNIT

PAPER NUMBER

3753

MAIL DATE

DELIVERY MODE

08/15/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/728,716

Applicant(s)

COLOMBO, RENATO

Examiner

Cloud K. Lee

Art Unit

3753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-15, 18-24, 27-29, 33 and 34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-15, 18-24, 27-29, 33 and 34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Italy on December 6, 2002. Applicant has filed a certified copy of the foreign application as required by 35 U.S.C. 119(b).

***Claim Objections***

1. Claim objections in the previous Office Action have been withdrawn.

***Claim Rejections - 35 USC § 112***

2. Claim Rejection under 35 U.S.C. 112, second paragraph in the previous Office Action have been withdrawn.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 12-15, 20-23, 27, 33, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Steele (US Patent Number 4,953,587).

Steele discloses a top-entry ball valve with both coupling members made integral with the valve body. The couplings are capable of being crimped. Please note, the anticipation is

based on an interpretation of the claims positively reciting the valve only and not additional structure, such as the conduit and female malleable sleeve.

5. Claims 12, 18-21, 27-29, 33, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Readman (WO 2000/39495).

It should be noted that these claims broadly recite a valve body without a flow control mechanism (which are not recited until dependent claims 13 and 22). A tube reads on the broad recitation to a valve body without a flow control mechanism. Readman discloses the coupling and conduit being the same size and crimped with a female malleable sleeve as well as parts being annealed.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 12-15, 18-24, 27-29, 33, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Readman in view of Steele.

If the claims are read so that every recitation is meant to be a positive recitation, Readman only lacks the top-entry ball valve. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used the top-entry ball valve of Steele with the coupling/conduit/female sleeve connection of Readman in order to control flow and allow the ball to be removed from the top rather than requiring removing the housing from the flow line as taught by Steele.

8. Claims 12-15, 18-24, 27-29, 33, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steele in view of Readman.

If the claims are read so that every recitation is meant to be a positive recitation, Steele only lacks the coupling/conduit/female sleeve connection. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used the coupling/conduit/female sleeve connection of Readman with the top-entry ball valve of Steele in order to connect the valve to a flow line in a leak-free manner as taught by Readman.

***Response to Arguments***

9. Applicant's arguments filed 06/18/07 have been fully considered but they are not persuasive.

In response to applicant's argument that Steele's reference does not teach or disclose couplings that are permanently capable to be crimped. The Examiner disagrees. Steele's reference clearly discloses a first and second male coupling (5) similar to Applicant's invention, and the first and second male coupling are structurally capable to be permanently crimped. Furthermore, the anticipation is based on an interpretation of the claims positively reciting the valve only and not additional structure, such as the conduit and female malleable sleeve, because the independent claims do not positively recite functional limitations "being permanently crimpable" and "sized to be inserted into". A recitation of the functional limitation of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In response to applicant's argument that Readman's reference does not teach or disclose couplings integrally formed with the valve body. The Examiner respectfully disagrees.

Readman's reference shows the coupling and the valve body are physically and structurally connected and contacted, therefore, Readman's reference discloses the couplings integrally formed with the valve body.

In response to applicant's argument that Readman's reference does not teach or disclose a valve body. The examiner respectfully disagrees. A tube reads on the broad recitation to a valve body without a flow control mechanism. Furthermore, a flow control mechanism which are not recited until dependent claims 13 and 22. Therefore, this is reasonable to call the tube a valve body since applicant does not recite a flow control mechanism until dependent claims 13 and 22.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art would be motivated to have used the coupling/conduit/female sleeve connection of Readman with the top-entry ball valve of Steele in order to connect the valve to a flow line in a leak-free manner as taught by Readman.

*Conclusion*

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Cloud K. Lee at telephone number (571)272-7206, who can normally be reached Monday-Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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